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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,388	02/21/2001	Sumiyo Okada	1573.1002	5407

21171 7590 03/25/2004

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EXAMINER
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CHEN, CHONGSHAN

ART UNIT	PAPER NUMBER
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2172

DATE-MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/788,388

Applicant(s)

OKADA ET AL.

Examiner

Chongshan Chen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36, 38-73 and 75-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36, 38-73 and 75-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: RCE, filed on 2 February 2004. This action is non-final.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-36 and 38-73 and 75-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1, 38 and 75, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claims 2-36, 39-73 and 76-78 are depend on the rejected claims.

5. The term "high" in claims 1, 38 and 75 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-36 and 38-73 and 75-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. ("Nishimoto", Japanese Patent, Document No. H10-69482).

As per claim 1, Norihiko teaches a message transmitting and receiving apparatus comprising:

a memory, storing keywords associated with said apparatus and degrees of importance of said keywords (Norihiko, [0010]);

a detector, detecting an occurrence of a transmitted or received message; an extractor, in response to the detection of an occurrence of a received message, extracting a keyword from said received message (Norihiko, [0018]-[0025]);

an indicator providing an indication of the occurrence of said extracted keyword within said received message in accordance with the determined degree of importance of said extracted keyword (Norihiko, [0005]-[0012]).

Norihiko discloses determining importance of a keyword ([0005]-[0025]), but Norihiko does not explicitly disclose determining dynamically a degree of importance of said extracted

keyword and updating said keywords and said degrees of importance in said memory such that which keywords are determined to have a high importance changes in accordance with time.

The examiner interprets the dynamic determining mean as a process in which the importance of a keyword may change based on various conditions during the determining process. Nishimoto teaches a method for determining the importance of a key and the importance of keyword changes during the process based on the appearance frequencies and appearance intervals (Nishimoto, page 11). Therefore, the importance determining mean of Nishimoto is dynamic. Furthermore, the dynamic determining mean of Nishimoto updates the degree of importance accordance with time. In Nishimoto's system, the keyword importance determining mechanism is used in a chat system and based on the appearance intervals of the respective keywords. There is a time difference between the appearance of words because words are spoken by a user one by one, which means the appearance intervals of the keywords means time intervals between the appearance. Clearly, the importance determining mechanism updates the importance based on the time of the appearance of the keyword. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the dynamic importance determining mean which updates the importance according to time in the system of Norihiko so that the chat system can track what topic the users are talking currently. This enables a chat participant to hold the flow of the talk easily.

As per claim 2, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach providing at least one of visual and audio indications of an occurrence of said extracted keyword in a manner determined by a degree of importance of said extracted keyword (Norihiko, [0005]).

As per claim 3, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach a deleting unit to delete a keyword having a degree of importance lower than a threshold value (Norihiko, [0022]).

As per claim 4, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach storing a new keyword extracted from a received message in said memory together with a degree of importance of said new keyword (Norihiko, [0018]).

As per claim 5, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach said extractor extracts also a candidate keyword from a received message, and said apparatus further comprises a register, storing in said memory, a candidate keyword as a keyword, together with a degree of importance of the candidate keyword, when a user of the apparatus responds to received message data containing the candidate keyword within a predetermined range (Norihiko, [0019]).

As per claim 6, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of messages. However, Norihiko discloses said predetermined range is a predetermined number of lines (Norihiko, [0019]). In the real-time chat system of Norihiko, usually one line is one message. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of messages in order to extract keywords from previous messages.

As per claim 7, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, and further teach said predetermined range is a predetermined number of lines (Norihiko, [0019]).

As per claim 8, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of words. However, Norihiko discloses said predetermined range is a predetermined number of lines (Norihiko, [0019]). The user would like to set the predetermined range as a predetermined number of words in order to further narrow the range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of words in order to define how many words the user wants to review.

As per claim 9, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of characters. However, Norihiko discloses said predetermined range is a predetermined number of lines (Norihiko, [0019]). The user would like to set the predetermined range as a predetermined number of characters in order to further narrow the range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of characters in order to define how many characters the user wants to review.

As per claim 10, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, and further teach said predetermined range is a predetermined time period (Nishimoto, page 11, In Nishimoto's system, the keyword importance determining mechanism is used in a chat system and based on the appearance intervals of the respective keywords. There is a time difference between the appearance of words because words are spoken by a user one by

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one, which means the appearance intervals of the keywords means time intervals between the appearance. Therefore, Nishimoto teaches determining importance using time period).

As per claim 11, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said message data within a predetermined range are messages received consecutively from a same client. However, the purpose of Norihiko's invention is for a chat participant to be able to hold the flow of the talk easily with another user. It is obvious the messages are received from a same client. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receive messages from a same client in order to concentrate on the chat with the same user.

As per claim 12, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword stored in said memory, depending on whether a user of the apparatus has responded to a received message containing said keyword (Norihiko, [0018]-[0019]).

As per claim 13, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword stored in said memory, depending on whether a user of the apparatus has responded to a received message containing said keyword within a predetermined range (Norihiko, [0018]-[0022]).

Claims 14-19 and 28-33 are rejected on grounds corresponding to the reasons given above for claims 6-11.

Claims 20-26 are rejected on grounds corresponding to the reasons given above for claims 1 and 10.



As per claim 27, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword in accordance with the number of occurrences of the keyword in a predetermined range of received message data (Norihiko, [0018]-[0022]).

Claim 34 is rejected on grounds corresponding to the reasons given above for claims 1 and 10.

As per claim 35, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword in accordance with an attribute of a received message containing the keyword (Norihiko, [0010]-[0015]).

As per claim 36, Norihiko and Nishimoto teach all the claimed subject matters as discussed in claim 35, and further teach the attribute of said received message is a network, a channel or a client (Norihiko, [0010]-[0015]).

Claims 38-48 are rejected on grounds corresponding to the reasons given above for claims 1-11.

Claims 49-55 are rejected on grounds corresponding to the reasons given above for claims 13-19.

Claim 56 is rejected on grounds corresponding to the reasons given above for claim 12.

Claims 57-73 are rejected on grounds corresponding to the reasons given above for claims 20-36.

Claim 75 is rejected on grounds corresponding to the reasons given above for claim 1.

Claim 76 is rejected on grounds corresponding to the reasons given above for claim 13.

Claim 77 is rejected on grounds corresponding to the reasons given above for claim 26.

Claim 78 is rejected on grounds corresponding to the reasons given above for claim 35.


***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is 703-305-8319. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703)305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 18, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER